

REMARKS

Claims 1-48 are pending in the application. The Examiner rejected claims 1-4, 8, 12-16, 20, 24-28, 32, 36-40, 44 and 48. The Examiner objected to claims 5-7, 9-11, 17-19, 21-23, 29-31, 33-35, 41-43 and 45-47 as being dependent upon a rejected base claim. Applicant thanks the Examiner for the indication of allowable subject matter. Claim amendments to place these claims in independent form are not currently presented in favor of the following arguments.

Claim Rejections - 35 U.S.C. §102

Claims 1-3, 13-15, 25-27 and 37-39 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,504,544 to Hollingsworth et al (“the Hollingsworth patent”). In particular, 35 U.S.C. 102(e) recites, in relevant part, “[a] person shall be entitled to a patent unless—the invention was described in . . . (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent . . .”(Emphasis added)

A rejection based on 35 U.S.C. 102(e) can be overcome by filing an affidavit or declaration under 37 C.F.R. 1.132 showing that the reference invention is not by “another.” (Manual of Patent Examining Procedure, Eighth Edition (MPEP), §706.02(b)). In particular, “when subject matter, disclosed but not claimed in a patent or application publication filed jointly by S and another, is claimed in a later application filed by S, the joint patent or application publication is a valid reference unless overcome by . . . an unequivocal declaration under 37 CFR 1.132 by S that he/she conceived or invented the subject matter disclosed in the patent or application publication and relied on in the rejection.” (See MPEP §715.01(a)).

In traversing this rejection, Applicant encloses a declaration under 37 C.F.R. §1.132 from inventor, Robert H. Halstead, Jr. In that declaration, Dr. Halstead acknowledges that he is a co-inventor of the Hollingsworth patent and that this cited patent describes a set of fundamental elastic operations (*i.e.*, “add,” “max,” “divide,” etc). See Halstead Decl. ¶¶ 4, 5. Dr. Halstead also acknowledges that the Hollingsworth patent suggests the possibility of other elastic operations, including an elastic subtraction operation. See Halstead Decl. ¶6.

Dr. Halstead declares that he alone conceived and invented these fundamental elastic operations and provided the suggestion that an elastic subtraction operation could be “envisioned.” See Halstead Decl. ¶¶ 5, 6. This assertion is supported by a declaration from David E. Hollingsworth, co-inventor of the Hollingsworth patent. See Hollingsworth Decl. ¶¶ 4, 5.

Dr. Halstead clarifies that at the time the Hollingsworth patent application was filed, he had no specific application that required an elastic subtraction operation. Thus, he provided no further description of the subtraction operation. See Halstead Decl. ¶6. Later, on or about August 5, 1999, Dr. Halstead states that he alone made the elastic subtraction operation for use in grid and table layouts using elastics, which is described and claimed in the present application. See Halstead Decl. ¶¶ 1, 7.

Thus, Dr. Halstead is the sole inventor of the elastic subtraction operation, which was suggested in the Hollingsworth patent and subsequently described and claimed in the present application. For at least this reason, the Hollingsworth patent should be disqualified as prior art because the subject matter of the elastic subtraction operation was not disclosed by another in the Hollingsworth patent.

Claim Rejections - 35 U.S.C. §103

Claims 4, 8, 12, 16, 20, 24, 28, 32, 36, 40, 44 and 48 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,504,544 to Hollingsworth et al (“the Hollingsworth patent”) in view of common knowledge in the art regarding processing of graphical objects.

Pursuant to 35 U.S.C. §103(c), the Hollingsworth patent should be disqualified as prior art, because this application and the Hollingsworth patent were owned by or subject to an obligation to assign to Curl Corporation at the time the invention of this application was made. 35 U.S.C. §103(c) applies to this application because it was filed after November 29, 1999 and the Examiner alleges that the Hollingsworth patent qualifies as prior art under 35 U.S.C. §102(e).

As further evidence, declarations from Robert H. Halstead, Jr. and David E. Hollingsworth are enclosed in which they state that they are both founders of Curl Corporation and have been subject to an obligation to assign to Curl Corporation since its founding in 1998. See Halstead Decl. ¶3; Hollingsworth Decl. ¶3. Dr. Halstead also states that on or about August 5, 1999, he alone made the elastic subtraction operation for use in grid and table layout using elastics and that this operation is described and claimed in the present application.

Assignment recordation notices (Exhibits A and B) are enclosed showing that this application and the Hollingsworth patent are presently commonly owned by Curl Corporation. In particular, Exhibit A shows that the Hollingsworth patent application was assigned to Curl by both inventors shortly after its filing on July 30, 1999.

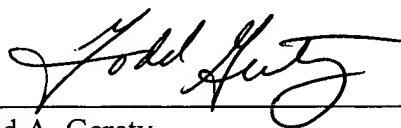
For at least these reasons, the Hollingsworth patent and the present application were owned by the same legal entity at all times and the Hollingsworth patent should be disqualified as prior art.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By 

Todd A. Gerety

Registration No. 51,729

Telephone: (978) 341-0036

Facsimile: (978) 341-0136

Concord, MA 01742-9133

Dated: 3/24/04